



Docket No.: B2745.0025

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Heidi Kay et al.

Application No.: 09/216,206

Confirmation No.: 1079

Filed: December 18, 1998

Art Unit: 3622

For: INTERNET ADVERTISING SYSTEM

Examiner: J. W. Myhre

PETITION TO CHANGE INVENTORSHIP UNDER 37 C.F.R. § 1.48

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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SEP 27 2004

GROUP 3600

Dear Sir:

Applicants request that the named inventors in the present application be corrected. The inventorship error being corrected occurred without any deceptive intent. The inventorship of the above-captioned application should be corrected to be David William Roth and Dylan Salisbury based on the previously submitted amendments and currently submitted amendment.

Included as tab 1 herewith is a statement executed by the Assignee stating that the error occurred without any deceptive intent on the part of either David William Roth or Dylan Salisbury. This statement by the Assignee is included herewith because, as described below, the inventors cannot be found or reached after diligent effort (37 C.F.R. § 1.47(b)).

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Applicants' representative has been unable to contact any of the named inventors as set forth in the Declaration of Ian R. Blum attached as tab 2. Therefore, enclosed is a Declaration naming each of the actual inventors, as permitted under 37 C.F.R. § 1.47. attached as tab 3.

The above-captioned application has been assigned to BEH Investments LLC. Enclosed is the Written Consent of BEH Investments LLC. Additionally, filed herewith is the assignment and recordation cover sheet. Attached at tab 4.

Applicants respectfully request a change of the inventorship of the above-captioned application as indicated herein.

If the Office believes an interview would be of assistance, the Office is welcome to contact the undersigned at the number listed below.

In the event a fee is required or if any additional fee during the prosecution of this application is not paid, the Patent Office is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 50-2215.

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If this communication is filed after the shortened statutory time period had elapsed and no separate Petition is enclosed, the Commissioner of Patents and Trademarks is petitioned, under 37 CFR 1.136(a), to extend the time for filing a response to the outstanding Office Action by the number of months which will avoid abandonment under 37 CFR 1.135. The fee under 37 CFR 1.17 should be charged to our Deposit Account No. 50-2215.

Dated: September 22, 2004

Respectfully submitted,

By 

Ian R. Blum

Registration No.: 42,336

DICKSTEIN SHAPIRO MORIN &
OSHINSKY LLP

1177 Avenue of the Americas
New York, New York 10036-2714
(212) 835-1400
Attorney for Applicant

IRB/mgs

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 262741538 US, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: 9/22/04

Signature: 

(Ian R. Blum)



PTO/SB/01 (08-03)

Approved for use through 07/31/2008, OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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DECLARATION FOR UTILITY OR DESIGN PATENT APPLICATION (37 CFR 1.63) <input type="checkbox"/> Declaration Submitted with Initial Filing OR <input checked="" type="checkbox"/> Declaration Submitted after Initial Filing (surcharge (37 CFR 1.16 (e)) required)	Attorney Docket Number	B2745.0025/P0025
	First Named Inventor	Heidi Kay
	COMPLETE IF KNOWN	
	Application Number	09/216,206-Conf. #1079
	Filing Date	December 18, 1998
	Art Unit	3622
	Examiner Name	J. Myhre

I hereby declare that:

Each inventor's residence, mailing address, and citizenship are as stated below next to their name.

I believe the inventor(s) named below to be the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

INTERNET ADVERTISING SYSTEM

(Title of the Invention)

the specification of which

☐ is attached hereto
OR☒ was filed on (MM/DD/YYYY) 12/18/1998 as United States Application Number or PCT International

Application Number 09/216,206 and was amended on (MM/DD/YYYY) 09/22/2003 (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment specifically referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT International filing date of the continuation-in-part application.

I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or (f), or 365(b) of any foreign application(s) for patent, inventor's or plant breeder's rights certificate(s), or 365 (a) of any PCT International application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent, inventor's or plant breeder's rights certificate(s), or any PCT International application having a filing date before that of the application on which priority is claimed.

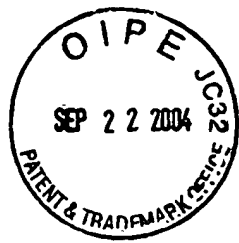
Prior Foreign Application Number(s)	Country	Foreign Filing Date (MM/DD/YYYY)	Priority Not Claimed	Certified Copy Attached?	
				YES	NO
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>

☐ Additional foreign application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto.RECEIVED
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DECLARATION — Utility or Design Patent Application

Direct all correspondence to: <input type="checkbox"/> Customer Number OR <input checked="" type="checkbox"/> Correspondence address below			
Name DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP Ian R. Blum			
Address 1177 Avenue of the Americas 41st Floor			
City	New York	State	NY
		ZIP	10036-2714
Country	US	Telephone	(212) 835-1400
		Fax	(212) 997-9880
I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.			
NAME OF SOLE OR FIRST INVENTOR:		<input checked="" type="checkbox"/> A petition has been filed for this unsigned inventor	
Given Name (first and middle (if any))	David William		Family Name or Surname Roth
Inventor's Signature	/ Benzion A. Wachsman / Benzion A. Wachsman for Assignee		Date 09/22/2004
Residence: City	State	Country	Citizenship
San Francisco	CA	United States of America	US
Mailing Address:	3650 Fillmore Street, #304		
City	State	ZIP	Country
San Francisco	CA	94123	United States of America
NAME OF SECOND INVENTOR:		<input checked="" type="checkbox"/> A petition has been filed for this unsigned inventor	
Given Name (first and middle (if any))	Dylan		Family Name or Surname Salisbury
Inventor's Signature	/ Benzion A. Wachsman / Benzion A. Wachsman for Assignee		Date 09/22/2004
Residence: City	State	Country	Citizenship
San Francisco	CA	United States of America	US
Mailing Address:	2854 Golden Gate Ave.		
City	State	ZIP	Country
San Francisco	CA	94118	United States of America
<input checked="" type="checkbox"/> Additional inventors or a legal representative are being named on the <u>1</u> supplemental sheet(s) PTO/SB/02A or 02LR attached hereto.			



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STATEMENT BY ASSIGNEE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Dear Sir:

I, Benzion A. Wachsman, am the President of BEH Investments LLC. I am authorized on behalf of BEH to sign documents. I hereby consent to the requested change of inventorship.

Attached hereto as Exhibit A is a Statement Under 37 C.F.R. § 3.73(b) regarding the chain of title to the invention set forth in Application No. 09/216,206.

My relation to the inventors set forth in the Declaration is Assignee of the invention disclosed in the above-captioned application.

I am signing the Declaration because the inventors are unavailable or unwilling to sign the Declaration. The inventors cannot be found or reached after diligent effort.

Submitted herewith is a Declaration by Ian R. Blum, Esq. setting forth the facts showing that the inventors are unavailable or unwilling to sign the attached Declaration.

The last known addresses of the inventors for the above-captioned application are:

Ms. Heidi Kay
2025 Francisco Street, Apt. I
Berkeley, California 94709

Mr. Russell Fradin
3600 Fillmore Street, Apt. 303
San Francisco, California 94123

Mr. David William Roth
3650 Fillmore Street, #314
San Francisco, California 94123

Mr. Dylan Salisbury
2854 Golden Gate Ave.
San Francisco, California 94118

Attached to the Declaration of Ian R. Blum, Esq. are the Express Mail labels indicating that Applicants attempted to contact the inventors in the above-captioned case. Delivery was attempted for each of the packages multiple times. However, the inventors either refused to accept delivery or have moved.

Applicants' representative attempted to contact Mr. David Roth by telephone. However, I understand that Mr. Roth refused to return any telephone calls.

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The filing of the present application is necessary to preserve the rights of BEH Investments LLC with respect to the invention disclosed in the above-captioned application and to prevent irreparable damage to BEH Investments LLC if this Declaration is not accepted.

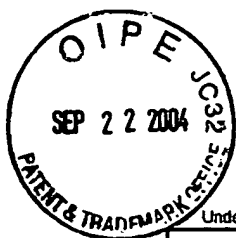
Dated: September 22, 2004

Respectfully submitted,

By / Benzion A. Wachsman /
Benzion A. Wachsman
BEH Investments LLC

IRB/mgs

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 262741538 US, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.	
Dated: <u>9/22/04</u>	Signature: <u>[Signature]</u> (Jan R. Blum)



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STATEMENT UNDER 37 CFR 3.73(b)

Applicant/Patent Owner: Heidi Kay et al.

Application No./Patent No.: 09/216,206 Filed/Issue Date: December 18, 1998

Entitled: INTERNET ADVERTISING SYSTEM

BEH Investments LLC, a Limited Liability Company
(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. ☐ the assignee of the entire right, title, and interest; or
2. ☒ an assignee of less than the entire right, title and interest.

The extent (by percentage) of its ownership interest is 100 %

in the patent application/patent identified above by virtue of either:

- A. ☐ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

OR

- B. ☒ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as shown below:

1. From: Heidi Kay and Russell Fradin To: Flycast Communications Corp.
The document was recorded in the United States Patent and Trademark Office at
Reel 9682, Frame 0336, or for which a copy thereof is attached.

2. From: Flycast Communications Corp. To: Engage Technologies, a/k/a Engage, Inc.
The document was recorded in the United States Patent and Trademark Office at
Reel 012077, Frame 0280, or for which a copy thereof is attached.

3. From: Engage Inc. To: BEH Investments LLC
The document was recorded in the United States Patent and Trademark Office at
Reel 013881, Frame 0442, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

- ☐ Copies of assignments or other documents in the chain of title are attached.
[NOTE: A separate copy (i.e., the original assignment document or a true copy of the original document) must be submitted to Assignment Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

09/22/2004

Date

(718) 928-2213

Telephone Number

Benzion A. Wachsman

Typed or printed name

/ Benzion A. Wachsman /

Signature

Authorized Signer for Assignee

Title

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